

**Remarks:**

The claims pending in this patent application at the time of the outstanding Office Action were claims 1-35 and 82-86. By this amendment, Applicant has (1) amended claims 1, 20, and 22, and (2) added new claims 91-97. Applicant notes that the amendments made to claims 1, 20 and 22 are merely cosmetic and the scope of these claims has not changed. Furthermore, no new matter has been added. Exemplary support for new claims 91-93 can be found in the patent application at p. 8 line 34. Exemplary support for new claim 94 can be found at p. 6, line 25 and Figure 3 (together with its corresponding descriptive text in the patent application). Exemplary support for new claim 95 can be found in Figure 2 (together with its corresponding descriptive text). Exemplary support for new claim 96 can be found at p. 7, line 38. Exemplary support for new claim 97 can be found at p. 66, line 23. The pending claims are now claims 1-35, 82-86, and 91-97.

The outstanding Office Action rejected all previously pending claims as follows: (1) claims 1-35 and 82-86 were rejected for allegedly being directed to non-statutory subject matter; (2) claims 82-86 were rejected under 35 USC 112 second paragraph for allegedly being indefinite; (3) claims 1-11, 16, 18, 20, 21, 27-32, 34-35, and 82 were rejected under 35 USC 102(b) as being anticipated by Mulinder; and (4) claims 12-15 and 33 were rejected under 35 USC 103(a) as being obvious over Mulinder in view of Bowman-Amuah ("Bowman").

**I. The USPTO is obligated to consider all references cited in Applicant's IDS**

At page 2, the Office Action states that the Examiner gave the references cited in Applicant's IDS only a cursory review, and the Office Action further invites Applicant to comment upon the "most relevant pieces of prior art" in this IDS. First, Applicant is aware of no obligation to comment upon the information submitted through an IDS. Second, Applicant notes that it has complied with the requirements of 37 CFR 1.97-98 with respect to the submission of references through the subject IDS. As such, Applicant asserts that it is entitled to full consideration of each reference submitted. Under MPEP §609:

Once the minimum requirements of 37 CFR 1.97 and 37 CFR 1.98 are met, ***the examiner has an obligation to consider the information.*** There is no

requirement that the information must be prior art references in order to be considered by the examiner. Consideration by the examiner of the information submitted in an IDS means nothing more than considering the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. The initials of the examiner placed adjacent to the citations on the \*\* PTO/SB/08A and 08B or its equivalent mean that the information has been considered by the examiner to the extent noted above. (See MPEP §609 (emphasis added);

See also MPEP §609.05(b)

"The information contained in information disclosure statements which comply with both the content requirements of 37 CFR 1.98 and the requirements, based on the time of filing the statement, of 37 CFR 1.97 *will be considered by the examiner. ... Examiners must consider all citations submitted in conformance with the rules*, and their initials when placed adjacent to the considered citations on the list or in the boxes provided on a form \*\* PTO/SB/08A and 08B provides a clear record of which citations have been considered by the Office. The examiner must also fill in his or her name and the date the information was considered in blocks at the bottom of the \*\* PTO/SB/08A and 08B form." (emphasis added).

## II. Claim Objections

The Office Action objected to claim 20 because "TCP/IP needs to be spelled out the first time it appears in the claim language." The Office Action further objected to claim 22 because "COM needs to be spelled out the first time it appears in the claim language." Claims 20 and 22 have been amended to spell out TCP/IP and COM, respectively. Furthermore, Applicant has amended the specification to similarly spell out TCP/IP in its first instance of usage. Applicant respectfully submits that no new matter has been added to the specification because a person having ordinary skill in the art would readily understood TCP/IP to have meant the well-known Internet Protocol Suite.

## III. All claims recite patentable subject matter under 35 USC 101

Regarding the rejections under 35 USC 101, the Office Action asserts that each of the three layers recited in claim 1 "are considered to be software per se." Contrary to this assertion, claim 1 contains hardware limitations, and as such is not directed to "software per

se". For example, claim 1 requires "a plurality of servers for processing the generated activity requests". As such, Applicant respectfully submits that claim 1 and all of its dependent claims satisfy 35 USC 101.

The Office Action also mistakenly identified claims 32-35 as being dependent from independent claim 1. However, claim 32 is an independent claim. Furthermore, claim 32 is not directed toward "software per se". For example, claim 32 recites "at least one order server," "at least one customer account server," and "at least one quote server."

The Office Action also rejects independent claim 82 under 35 USC 101 because "it is unclear whether claim 82 is a system or method claim". Applicant respectfully submits that this is not an appropriate basis for rejecting a claim under 35 USC 101. However, Applicant notes that the Office Action repeats this rationale in a rejection of claims 82-86 for indefiniteness under 35 USC 112. Applicant will address the indefiniteness issues below.

#### **IV. Claims 82-86 are not indefinite**

Regarding the rejection of claims 82-86 under 35 USC 112, the Office Action asserts that these claims are indefinite because "[i]t is unclear whether claim 82 is a system or method claim." However, the body of claim 82 clearly recites method steps as each step begins with a present participle verb. Furthermore, the preamble of claim 82 identifies the claim as being directed toward "a method comprising", with the method being performed "[i]n an automated financial instrument brokerage system". Thus, Applicant respectfully submits that claims 82-86 are not indefinite because a person having ordinary skill in the art would readily understand that claim 82 is directed toward a method comprising a plurality of steps.

#### **V. Claims 1-11, 16, 18, 20-21, 27-32, 34-35, and 82 are not anticipated by Mulinder:**

Regarding the rejections under 35 USC 102, the Office Action asserts that claims 1-11, 16, 18, 20, 21, 27-32, 34-35, and 82 are anticipated by Mulinder. The independent ones of these claims are claims 1, 32 and 82. Mulinder discloses a system including a "client access device 2", a "foreign exchange services provider 3" and a "communications server 5". (See Mulinder, Figure 2).

Applicant respectfully submits that the Office Action fails to make out a *prima facie* case for anticipation because the Office Action is vague as to how Mulinder allegedly discloses every element of the rejected claims. For example, claim 1 recites three layers: a “front end layer,” an “intermediate layer” and a “back end layer.” Applicant notes that the Office Action’s rejection is not clear regarding the correspondence between the claimed layers and the components disclosed in Mulinder. While the Office Action at pages 4-5 cites to paragraphs 9, 43, and 45 of Mulinder as allegedly disclosing the “front end layer...” and “intermediate layer...” limitations of claim 1, the Office Action fails to specifically identify which components of the Mulinder system described in these paragraphs meet which limitations of the claim. On this subject, Applicant notes that paragraph 9 of Mulinder does not even address Mulinder’s system. Instead, paragraph 9 describes a prior art system and merely characterizes that prior art system as employing a client-server architecture with pre-defined user interfaces. While paragraphs 43 and 45 actually address Mulinder’s system, Applicant notes that these paragraphs describe a number of components of the Mulinder system, and the Office Action does not identify which components meet which limitations of claim 1. The U.S. Supreme Court has stated that the analysis supporting rejections should be made explicit to facilitate review, and that rejections cannot be sustained by mere conclusory statements. “To facilitate review, this analysis should be made explicit. [R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” KSR Intern. Co. v. Teleflex, 127 S.Ct. 1727,1741 (U.S. 2007)[citing In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)]. The requirement for explicit rejection is not limited to obviousness rejections. “This requirement is as much rooted in the Administrative Procedure Act, which ensures due process and non-arbitrary decisionmaking, as it is in § 103.” In re Kahn, 441 F.3d at 988.

Moreover, the USPTO bears the initial burden of presenting a *prima facie* case of anticipation. In re Wilder, 429 F. 2d 447 (CCPA 1970). A *prima facie* case of anticipation is made out whenever a reference is shown to contain a disclosure which is specific as to every element of the rejected claims. In re Wagner, Appeal No. 2000-1475, page 7 (BPAI 2000)(emphasis added)(non-precedential and not selected for publication). In this case, the

Office Action has not made a *prima facie* case because it has not specifically explained which elements in Mulinder allegedly discloses each of the three layers recited in claim 1. Applicant respectfully requests that the Examiner provide a more specific, feature-by-feature analysis of how Mulinder allegedly discloses every element of the rejected claims. The rejections of independent claims 32 and 82 suffer from the same deficiency.

Notwithstanding this deficiency in the Office Action, in an effort to advance prosecution, Applicant interprets the Office Action's rejection of claim 1 as asserting that the "intermediate layer" of claim 1 is allegedly met by Mulinder's "quote engine 9" and "trade aggregator 19". However, Applicant respectfully submits that such an anticipation rejection is improper because claim 1 requires that the "intermediate layer" comprises "a plurality of servers for processing the generated activity requests, the servers being configured to provide a set of services in connection with the processing of the activity requests". However, Applicant respectfully submits that Mulinder fails to disclose the implementation of the quote engine 9 and trade aggregator 19 on different servers. Instead, Applicant respectfully submits that paragraph 64 must be interpreted as disclosing that the quote engine 9 and trade aggregator 19 are implemented as different software programs on the same machine. (See Mulinder, paragraph 64; "[b]ased on the above description, it will be obvious to one of ordinary skill to implement the present invention in one or more computer programs that are executable on a programmable system including at least one programmable processor..." (emphasis added)). Furthermore, given that Figure 2 specifically identifies component 5 as a communication server, but does not employ the term "server" to describe the "quote engine 9" and "trade aggregator 19", Applicant respectfully submits that this leads to a conclusion that the trade aggregator and quote engine are different software programs on the same machine rather than different servers, as required by claim 1.

Applicant further notes that the rejection of claim 32 for anticipation is deficient for the same reasons.

Furthermore, with respect to independent claim 82, Applicant respectfully submits that Mulinder fails to disclose the user of "a plurality of heterogeneous applications" in the first layer and the use of "a common interface for each of the heterogeneous applications", as recited by claim 82.

Applicant further submits that the anticipation rejection based on Mulinder is deficient with respect to the dependent claims for a number of reasons. For example, with respect to dependent claims 16 and 18, Applicant respectfully submits that the Office Action's rejection of these claims is based on a mischaracterization of Mulinder. The Office Action cites to paragraph 13 and 49 of Mulinder as allegedly disclosing memory resident on the intermediate layer's customer account server for storing customer account data that has previously been retrieved from the back end data repository. But Mulinder does not disclose such a memory. Paragraph 13 of Mulinder pertains to performing a credit check on a client, and does not discuss how memory is utilized in this check. Paragraph 49 of Mulinder relates to review of price quotes and dealer intervention, and does not discuss how memory is used for storing customer account data. Applicant notes that by retaining customer account data in memory within the intermediate layer in this manner, the system is able to operate more efficiently because the number of accesses into the back end data repository will be reduced.

**VI. Claims 12-15 and 33 are not obvious based on Mulinder and Bowman**

The Office Action rejected dependent claims 12-15 and 33 as being obvious over Mulinder in combination with Bowman. The Office Action further rejected dependent claims 17, 19, 22-26, and 83-86 for obviousness over Mulinder in combination with "Official Notice." Applicant submits that all of the rejected dependent claims are patentable by virtue of the deficiencies noted above with respect to the independent claims as against Mulinder. The Office Action's citation to Bowman and "Official Notice" as against claims 12-15 and 33 fails to bridge the gaps left by Mulinder. In short, Applicant respectfully submits that the obviousness rejections are improper because they are based on a mischaracterization of Mulinder.

**Conclusion:**

For the foregoing reasons, Applicant respectfully submits that the pending claims are in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to

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telephone the undersigned at the number provided below. Favorable action is respectfully requested.

Respectfully submitted,



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